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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

This office action is in response to applicants' response filed 2/28/07. Claims 1-35 are

pending in the application.

Claim Objections

Claims 3, 9, 11, 14, 19, and 31-33 objected to because of the following

informalities: Claim 3 repeats the step g, which was already recited in claim 2. Claim 9

recites step g1, which was already cited in claim 8. Claim 11 recites step d1, which was

already discussed in claim 4. Claims 14 and 19 repeat step e recited in claims 13 and

18. Claims 30-32 recite step d1. Claim 33 recites step d, which was already discussed

in claim 28. Appropriate correction is required.

Claim 24, step b is missing. Correction is required.

Claim 34, at the end of step d), please delete --and--.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claim 34 is directed to non-statutory subject matter. The claim recites a computer

usable medium. However, the specification at page 71, paragraph 183 maintains that

the medium can be transmitted in carrier wave. Furthermore, the medium can be a

communication lines and optical lines. Therefore, the claim is non-statutory because the

claim deals with intangible media that are incapable of being touched or perceived.

Correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3, 14, and 19 of the instant application are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 6, 11, 16-17 of copending patent application publication number 2004/0177114A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are narrower than the claims of copending patent application publication number "114" and copending patent application publication number "681", which encompass the same metes and bounds. For instance, claim 1 of US application "114" contains the steps of maintaining in a memory data defining a greeting card and any modifications thereto, which is similar to step b) maintaining and identifying greeting card templates and any user defined modifications and step c) of the present application; printing the greeting

card in conjunction with any modifications thereto is similar to printing on demand

personalized card ... in conjunction with any user defined modifications thereto;

generating from the readable data printed on the greeting card a document useable to

help match the printed greeting card with another item; this step is similar to steps e)

and f) of the present application. The only step missing in US application "114" is step a)

of the present US application. It has been held that omission of an element and its

function and a combination where the remaining elements perform the same function as

before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to claims 1-35 have been considered but are

moot in view of the new ground(s) of rejection.

During patent examination, the pending claims have been "given* their

broadest reasonable interpretation consistent with the specification." In re Hyatt,

211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-21, 24-29, and 34-35 are rejected under 35 U.S.C. 102(b) as being

clearly anticipated by Small US patent number 5,513117.

As per claim 35, Small teaches a computer system connectable to a computer network

comprising: (a) a processor (fig 2 element 15); (b) a memory coupled to the processor

for storing (16); (i) data identifying one of the greeting card templates and any user

defined modifications thereto (col. 6 lines 33-46); and (ii) data associating said one

greeting card template with a gift card (col. 6 lines 33-46); (c) a printer coupled to the

processor (element 23); (d) program logic for printing on demand a personalized

greeting card comprising the identified greeting card template in conjunction with any

user defined modifications thereto and greeting card data reference thereon (col. 8 lines

9-10); e) program logic generating a personalized gift card having a gift card data

reference thereon (col. 8 lines 10-17; and (f) program logic for comparing the greeting

card data reference and the gift card data reference to determine a relationship

therebetween (see fig 6 and 9-11; col. 9 line 65 to col. 10 line 4; the gift card data

reference can be printed on the greeting card or can simply be printed separately and

associated with the greeting card).

As per claim 1, Small teaches in a computer system connectable to a computer

network, a method comprising: (a) maintaining in memory a compilation of greeting card

templates (col. 6 lines 33-46); (b) maintaining in memory data identifying one of the

greeting card templates and any user defined modifications thereto (col. 6 lines 33-46;

message can be altered or added in the card); (c) maintaining in memory data

associating said one greeting card template and any user defined modifications thereto with a gift card (col. 6 lines 33-46); (d) printing on demand a personalized greeting card comprising the identified greeting card template in conjunction with any user defined modifications thereto and greeting card data reference thereon (col. 8 lines 9-10); and (e) generating a gift card having a gift card data reference thereon (col. 8 lines 10-17); (f) comparing the greeting card data reference and the gift card data reference to determine a relationship therebetween (see fig 6 and 9-11; col. 9 line 65 to col. 10 line 4; the gift card data reference can be printed on the greeting card or can simply be printed separately and associated with the greeting card).

As per claim 2, Small teaches the method of claim 1 further comprising: (g) combining the gift card with the personalized greeting card (see fig 10-11; col. 10 lines 11-20).

As per claim 3, Small teaches the method of claim 1 further comprising: (g) shipping the gift card with the personalized greeting card to a designated recipient (see fig 7, element 115).

As per claim 7, Small teaches the method of claim 1 wherein (f) comprises: (f1) reading the greeting card reference data; (f2) reading the gift card reference data; and (f3) confirming that the personalized greeting card represented by the read greeting card reference data and gift card represented by the read gift card reference data are associated (see fig 6, and 10-11).

As per claim 8, Small teaches the method of claim 2 wherein (g) comprises: (g1)

attaching the gift card to a panel of the greeting card (see col. 10 lines 1-4 where the gift card can be printed directly on the card or associated with the greeting card, which implies combination or attachment).

As per claim 9, Small teaches the method of claim 2 wherein (g) comprises: (g1) inserting the gift card into a panel of the greeting card (see fig 10 where a gift card is inserted into a greeting card panel).

As per claim 10, Small teaches the method of claim 1 wherein (c) comprises: (c1) maintaining in memory data representing any of a greeting card identifier, greeting card modification identifiers, destination address, gift card identifier, gift card value, and vendor transaction identifier (see fig 2 element 24).

As per claim 11, Small teaches the method of claim 1 wherein (d) comprises: (d1) printing a personalized greeting card upon the occurrence of a predetermined event selected from the group consisting of: receipt of a computer instruction, the occurrence of a temporal event, and the notification of a completed task (see fig 9 col. 9 line 59 to col. 10 line 4).

As per claim 12, Small teaches in a computer system connectable to a computer network, a method comprising: (a) maintaining data associating a greeting card with the gift card (col. 6 lines 33-46); (b) generating on demand a personalized greeting card with a greeting card data reference thereon (col. 6 lines 33-46); (c) using the greeting card data reference to initiate generation of a gift card having a gift card data reference

thereon (fig 7, elements 11 and 112; fig 11); (d) reading the greeting card reference

data (see fig 10-11); (e) reading the gift card reference data; and (f) determining if the

personalized greeting card represented by the read greeting card reference data and

gift card represented by the gift card reference are associated (see (see fig 6 and 9-11;

col. 9 line 65 to col. 10 line 4; the gift card data reference can be printed on the greeting

card or can simply be printed separately and associated with the greeting card).

As per claim 13, Small teaches the method of claim 12 further comprising: (e)

combining the gift card with the personalized greeting card, if the personalized greeting

card represented by the read greeting card reference data and gift card represented by

the gift card reference are associated (see fig 7, 9-11; col. 9 line 65 to col. 10 line 4; the

gift card data reference can be printed on the greeting card or can simply be printed

separately and associated with the greeting card).

As per claim 14, Small teaches the method of claim 12 further comprising: (e) shipping

the gift card with the personalized greeting card to a designated recipient, if the

personalized greeting card represented by the read greeting card reference data and

gift card represented by the gift card reference are associated (see fig 7, element 115).

As per claim 15, Small teaches the method of claim 12 wherein the personalized

greeting card comprises a greeting card template and any user defined modifications

thereto and wherein (b) comprises: (b1) printing a greeting card template in conjunction

with any user defined modifications thereto upon the occurrence of a predetermined event (see fig 9 col. 9 line 59 to col. 10 line 4).

As per claim 16, Small teaches the method of claim 15 wherein the predetermined event is selected from the group consisting of: receipt of a computer instruction, the occurrence of a temporal event, and the notification of a completed task (see fig 9 col. 9 line 59 to col. 10 line 4).

All the features described in claims 17-21 have already been discussed in claims 1-16 above. They are rejected under the same rationale.

As per claim 24, Small teaches in a computer system connectable to a computer network, a method comprising: (a) maintaining in memory data identifying a greeting card template and any user defined modifications thereto and data associating the gift card template with a gift card (col. 6 lines 33-46); (c) upon the occurrence of a first predetermined event, printing a personalized greeting card comprising the identified greeting card template in conjunction with any user defined modifications thereto and greeting card data reference thereon (see fig 9 col. 9 line 59 to col. 10 line 4); (d) upon the occurrence of a second predetermined event, generating a gift card with a gift card data reference thereon (fig 7 elements 111-113); and (e) comparing the gift card data reference and the greeting card data reference to determine a relationship therebetween (see fig 6 and 9-11; col. 9 line 65 to col. 10 line 4).

As per claim 25, Small teaches the method of claim 24 wherein one of the first and

second predetermined events are selected from the group consisting of: receipt of a

computer instruction, the occurrence of a temporal event, and the notification of a

completed task (see fig 7 elements 111-113).

As per claim 26, Small teaches the method of claim 24 wherein the first and second

predetermined events occur simultaneously (see fig 7, elements 111-113).

As per claim 27, small teaches the method of claim 24 wherein the first and second

predetermined events occur in a sequence (see fig 7 elements 111-113).

As per claim 28, Small teaches in a computer system connectable to a computer

network, a method comprising: (a) maintaining in memory a compilation of greeting card

templates (see col. 6 lines 33-46); (b) maintaining in memory data identifying a plurality

of the greeting card templates, any user defined modifications thereto, and data

associating each of the plurality of greeting card templates with one of a plurality of the

gift cards (col. 6 lines 33-46); (c) printing, in a sequence (inherent in printing the card), a

plurality personalized greeting cards, each of the personalized greeting cards

comprising one of the identified greeting card templates in conjunction with any user

defined modifications thereto and a greeting card data reference thereon (col. 6 lines

33-46; fig 7 item 114; fig 9 items 161, 165-166); and (d) generating, on demand and in a

sequence, a plurality of a gift card, each gift card having a gift card data reference thereon (col. 8 lines 10-17); (e) comparing the greeting card data reference of a greeting card having a position in the sequence of personalized greeting cards with the gift card data reference of a gift card having a similar position in sequence of gift cards to determine a relationship therebetween (see fig 6 and 9-11; col. 9 line 65 to col. 10 line 4).

As per claim 29, Small teaches the method of claim 28 further comprising: (f) combining the gift card with the personalized greeting card, if the personalized greeting card represented by the greeting card data reference and gift card represented by the gift card data reference are associated (see fig 6 and 10-11).

As per claim 34, Small teaches a computer program product for use with a computer system operatively coupled to a computer network comprises a computer usable medium having program code embodied thereon, the program code comprising: (a) program code for maintaining in memory a compilation of greeting card templates (col. 6 lines 33-46); (b) program code for maintaining in memory data identifying one of the greeting card templates and any user defined modifications thereto (col. 6 lines 33-46); (c) program code for maintaining in memory data associating said one greeting card template and any user defined modifications thereto with a gift card (col. 6 lines 33-46); (d) program code for printing on demand a personalized greeting card comprising the identified greeting card template in conjunction with any user defined modifications

thereto and greeting card data reference thereon (col. 8, lines 9-10); and (e) program

code for generating a gift card having a gift card data reference thereon; and (f)

program code for comparing the greeting card data reference and the gift card data

reference to determine a relationship therebetween (see fig 6 and 9-11; col. 9 line 65 to

col. 10 line 4; the gift card data reference can be printed on the greeting card or can

simply be printed separately and associated with the greeting card).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6, 22-23 and 30-33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Small.

As per claims 4-6, 22, and 30-33, Small teaches printing a gift card and a greeting card

(col. 10 lines 1-4; fig 7 element 114). However, Small does not specifically detail on

printing front panels of the personalized greeting card, printing a first of the at least two

gift card panels, and printing at least a first of the two gift card panels with at least a

portion of an image from at least one panel of the personalized greeting. Official notice

is taken that both the concept and the advantages of printing a specific panel of a card

is well know and expected in the art. It would have been obvious to one of ordinary skill in the art to include printing of the front and a first of the at least two gift card panels to Small as this method is known to facilitate association and/or combination of a gift and greeting card.

As per claim 23, Small does not explicitly teach greeting card template that has n panels where n>2 and wherein (c1) comprises: (c1a) printing greater than two panels on card stock. Official notice is taken in that having a greeting card that contains more than 2 panels and printing greater than two panels are well known in the art for design purposes and convenience. It would have been obvious to one ordinary skill in the art at the time of the invention to include multiple panels into Small greeting card to facilitate gift attachment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tackbary et al. (5555496), Spector (5870718), Simpson (6453300) and Chatuverdi et al (EP 0784394A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frantz Jean

FRANTZ B. JEAN
PRIMARY EXAMINER